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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,949	03/30/2001	Solimabi Wahidullah	01-391	3917

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CHICAGO, IL 60606

EXAMINER

MINNIFIELD, NITA M

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/821,949

Applicant(s)

WAHIDULLAH ET AL.

Examiner

N. M. Minnifield

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicants' amendment filed May 9, 2003 is acknowledged and has been entered. Claims 1-32 have been canceled. New claims 33-43 have been added. New claims 33-43 correspond to the elected invention of Group I of the restriction requirement set forth in Paper No. 5. All rejections have been withdrawn in view of Applicants' amendment and/or comments with the exception of those discussed below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 34-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite because they depend from canceled claim 1. In an effort to continue prosecution the Examiner is interpreting the claims to depend from independent claim 33.
4. Claims 33-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hedge et al, Bloor, or Podolak et al.

The claims are directed to an oleanane triterpenoid oligoglycoside.

Hedge et al disclose triterpene compound (abstract; materials and methods; figures).

Bloor discloses a triterpene saponin and those these were oleanane-type saponins (abstract).

Podolak et al discloses a triterpene saponoside compound that has antifungal activity (abstract; p, S70 column 1). Podolak et al disclose that the isolated compound has antifungal activity against *Candida albicans* (p. S71, column 2).

The claims are directed to compounds which the prior art appears to disclose. The prior art appears to disclose the same or similar formula as set forth in formula 1. While the compounds of the reference were not obtained from source, they nevertheless appear to be the same or an obvious or analogous variant of the compound broadly and non-specifically claimed by applicants because they appear to possess the same or similar functional characteristics, i.e. oleanane triterpene and have antifungal activity. The source of a particular compound does not impart novelty or unobviousness to a particular compound when said compound is taught by the prior art. Since the Patent Office does not have the facilities for examining and comparing applicants' compound with the compound of the prior art reference, the burden is upon applicants to show an unobvious distinction between the material structural and functional characteristics of the claimed compound and the compound of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

It is noted that the recitation of "is used for the treatment..." and "is used as a food preservative" is viewed as intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended

use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

It is noted that this prior art rejection is maintained for new claims 33-43. Applicant's arguments filed May 9, 2003 have been fully considered but they are not persuasive. Applicants have asserted that none of the prior art references (Hedge et al, Bloor, and Podolak et al) disclose the compounds of the present invention, which have distinct chemical entities. Applicants have asserted that the prior art compounds do not have the rhamnose, rhamnose, glucose glucuronic acid and glucose sugar series at the 3-position of the molecule. Applicants have also asserted that the prior art does not disclose that the compound is isolated from *Aegiceras corniculatum*. Applicants have asserted that one of skill in the art (i.e. organic chemist) would know that the structures of the prior art compounds versus the claimed compounds would have different properties and further that since these compounds are structurally different there is no reason for a medicinal chemist to expect that the compounds of the prior art references would have the same biological activities as the claimed compounds.

With regard to Applicants' comments regarding the structure of the compounds, as previously stated the prior art appears to disclose the same or similar formula as set forth in formula 1. While the compounds of the reference were not obtained from the same source, they nevertheless appear to be the same or an obvious or analogous variant of the compound broadly and non-specifically claimed by applicants because they appear to possess the same or similar functional characteristics, i.e. oleanane triterpene and have antifungal activity. The

source of a particular compound does not impart novelty or unobviousness to a particular compound when said compound is taught by the prior art. Further, the specific sugar residues do not appear to impart any novelty or special characteristics since the compounds function in the manner as claimed by Applicants.

Applicants have also asserted that the prior art does not disclose that compound is isolated from *Aegiceras corniculatum*. However, it is noted that "isolated from" is viewed as a process limitation. The claimed in directed to a product, an oleanane triterpenoid oligoglycoside, which the prior art references disclose.

Applicants have asserted that one of skill in the art (i.e. organic chemist) would know that the structures of prior art compounds versus the claimed compounds would have different properties and further that since these compounds are structurally different there is no reason for a medicinal chemist to expect that the compounds of the prior art references would have the same biological activities as the claimed compounds. However, one of skill in the art would expect that compounds having similar or analogous structures (analogous variants) would function in the same manner, as is set forth in the prior art references.

Since the Patent Office does not have the facilities for examining and comparing applicants' compounds with the compounds of the prior art references, the burden is upon applicants to show an unobvious distinction between the material structural and functional characteristics of the claimed compounds and the compounds of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

5. No claims are allowed.
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 703-305-3394. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

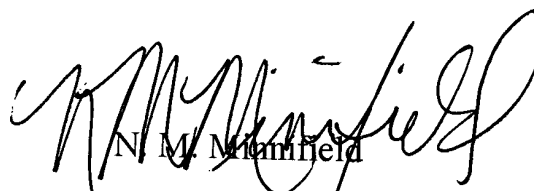
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R.F. Smith can be reached on 703-308-3909. The

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fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
N. M. Mumfield  
Primary Examiner  
Art Unit 1645

NMM

July 18, 2003